



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/711,648	11/13/2000	Dean M. Ponzi	37646/KMO/W112	7874
23363 7590 11/03/2008 CHRISTIE, PARKER & HALE, LLP PO BOX 7068 PASADENA, CA 91109-7068				
EXAMINER MACNEILL, ELIZABETH				
ART UNIT		PAPER NUMBER		
3767				
MAIL DATE		DELIVERY MODE		
11/03/2008		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

09/711,648

Applicant(s)

PONZI ET AL.

Examiner

ELIZABETH R. MACNEILL

Art Unit

3767

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 September 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20, 23-28, 30-35, 39 and 42-47 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20, 23-28, 30-35, 39 and 42-47 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 17 September 2008 has been entered.

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-3, 5-20,23-25,27,28,30-35,39 and 42-47 are rejected under 35 U.S.C. 103(a) as being unpatentable over ABELE (US #5,403,311) in view of West et al (US 5,318,525)

Regarding claim 1, Abele teaches "An injection catheter comprising: a catheter body (28) comprising a flexible tubing (30) having proximal and distal ends and at least one lumen (not labeled, Col 5 lines 47-65) there through; a tip section (e.g. 52) having a longitudinal axis and comprising a flexible tubing having proximal and distal ends, wherein the proximal end of the tip section is mounted at the distal end of the catheter

body (Fig 1, Fig 6); a needle control handle (17) at the proximal end of the catheter body; an injection needle (24) extending through the tip section, catheter body, and needle control handle and having a proximal end attached to the needle control handle and a distal end within the tip section, wherein the injection needle is longitudinally slidable within the tip section so that upon suitable manipulation of the needle control handle the distal end of the injection needle can extend distally beyond the distal end of the tip section in a direction along the longitudinal axis of the tip section to penetrate tissue generally facing a distal face of the tip section (Fig 1); an electrode lead wire having a first end electrically connected to the injection needle (26) and a second end electrically connected to a suitable monitoring apparatus or to a source of ablation energy (16), with a penetration monitoring electrode mounted on the injection needle.” See also Col 3, lines 25-52, and Col 4 lines 19-29, and Col 5 lines 53-55. As to the plastic tubing, Abele discloses that the injection needle comprises plastic tubing (34) which is a plastic (polyamide) insulating sheath. Fig 2.

Abele does not teach a puller wire and deflection control handle for controlling the deflection of the tip section. West teaches a catheter with puller wire (44) connected to the distal end of a tip section of a catheter (16) and connected to a deflection control handle (24) which controls deflection of the catheter tip (Fig 2). It would have been obvious to one of ordinary skill in the art at the time the invention was made to use the puller wires of West with the catheter of Abele in order to controllably steer the catheter through the vasculature to the desired treatment location in the body.

Regarding claims 9 and 11, Abele teaches the limitations of claim 1 above, with the substitution and/or addition of an electrode mounted on the injection needle being electrically isolated for the injection needle. (Col 8 lines 50-Col 9 line 5).

Regarding claim 23, the claim recites the same limitations as claim 1 without explicitly defining the tip section. Examiner takes the proximal end of the catheter to be equivalent to the tip section of claim 1; therefore claim 23 is rejected under Abele.

Regarding claims 2,3,24, and 25, the electrode can be mounted at the distal or proximal end of the injection needle (52, 56)

Regarding claims 5,6,27 and 28, Examiner takes the protective tube to be the cross-braided stainless steel filaments 30.

Regarding claims 7, 14, 19, and 46, Abele teaches the use of at least one additional electrode (Fig 10, 72 and 74)

Regarding claim 8, Abele teaches that the tip of the needle can be an electrode (Col 6 line 15)

Regarding claim 10, Abele teaches the use of a ring electrode (e.g. 26, Col 5 line 51)

Regarding the method claims 12, 13, 15, 17, 18, 20, 30-35, 44, 45, and 47, Abele describes various potential methods of use, disclosing all of the claimed methods. See "Summary of the Invention" and "Description of Preferred Embodiments." group angiogenesis activators, angiogenesis inhibitors, and antiarrhythmic drugs."

As to claim 16, Abele teaches the limitations of claims 12 and 1, but only specifies the use of a “vasoconstrictor, sclerotic, topical anesthetic, or heat responsive drug.”

Because Abele’s catheter and the disclosed invention are both designed to be used to abate tissue in the heart, the selection of one drug over another is a matter of obvious design choice.

3. Claims 4 and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Abele and West as applied to claims 1 and 23 above, and further in view of COSMAN (US #4,966,597).

Abele and West teach the limitations of a catheter for introduction into cardiac tissues, but does not teach the use of a pair of copper and constantan wires used as a thermocouple probe.

Cosman teaches the use of a thermocouple composed of copper and constantan wires (elements 1 and 5) in a cardiac catheter (Fig 3).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to combine the electrode thermocouple probe of Cosman with the cardiac catheter of Abele and West in order to facilitate “true surface temperature recording with fast response” (Cosman Abstract)

Response to Arguments

Applicant’s arguments filed 17 September 2008 have been considered but moot in the view of the new grounds of rejection.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to ELIZABETH R. MACNEILL whose telephone number is (571)272-9970. The examiner can normally be reached on 9:00-5:30 M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kevin Simons can be reached on (571) 272-4965. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Elizabeth R MacNeill/
Examiner, Art Unit 3767
/Kevin C. Simons/
Supervisory Patent Examiner, Art Unit 3767